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No. 92-1760

IN THE

Supreme Court of the United States

OCTOBER TERM, 1992

DAVID DECOSTA, AS EXECUTOR OF THE ESTATE OF VICTOR DECOSTA,
Petitioner,

—v.—

VIACOM INTERNATIONAL,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED FOR REVIEW

Does the doctrine of collateral estoppel bar a second action for service mark infringement and unfair competition, where (1) petitioner brought a prior action based upon the same conduct by petitioner and by respondent's predecessor-in-interest, (2) the prior action resulted in a final judgment against petitioner on the ground that concurrent use of the mark was not likely to cause confusion, and (3) neither the facts nor the law have changed since the prior judgment?

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No. 92-1760

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1992

DAVID DeCOSTA, AS EXECUTOR OF
THE ESTATE OF VICTOR DeCOSTA,

Petitioner,

v.

VIACOM INTERNATIONAL, INC.

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI

PRELIMINARY STATEMENT

This is a straightforward case of collateral estoppel. Having lost a thirteen-year court battle against CBS

Inc. ("CBS"), petitioner then sought to hold CBS' privy, Viacom International Inc. ("Viacom"), liable for the very same conduct which the First Circuit held, eighteen years earlier, did not provide any "predicate of liability" to petitioner -- the broadcast of the television series "Have Gun -- Will Travel."[1]

Because neither the facts nor the law have changed since the prior litigation, the First Circuit properly held that,

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[1] The First Circuit's opinion in this case is reported as *DeCosta v. Viacom International Inc.*, 981 F.2d 602 (1st Cir. 1992) ("DeCosta III"). The First Circuit's prior opinions are reported as *CBS Inc. v. DeCosta*, 377 F.2d 315 (1st Cir.), *cert. denied*, 389 U.S. 1007 (1967) ("DeCosta I"), and *CBS Inc. v. DeCosta*, 520 F.2d 499 (1st Cir. 1975), *cert. denied*, 423 U.S. 1073 (1976) ("DeCosta II"). *DeCosta II* and *DeCosta III* are reproduced in the Appendix to the Petition, referred to hereinafter as "A__". The Appendix to Respondent's Brief in Opposition is referred to herein as "Opp. App. ____."

under the doctrine of collateral estoppel, the prior finding of no "likelihood of confusion" bars petitioner's "new" complaint:

> Mr. DeCosta's argument on this appeal consists of an attempt to escape the bonds of "collateral estoppel" through a claim that legal and factual changes since 1975 (when we decided *DeCosta II*) make the "confusion" issue, in essence, a new one. *See Restatement (Second) of Judgments* § 27, cmt. c; § 28(2)(b), (4) (collateral estoppel does not bar relitigation of an issue transformed by significant factual or legal changes). After considering Mr. DeCosta's arguments in detail, however, we find no legally significant change.

DeCosta III, A5.

Thus, petitioner misrepresents the holding below when he argues that the First Circuit "announce[d] a rule that no matter how significant changed circumstances may be, a prior finding of likelihood of confusion *forever* bars DeCosta from entering into Viacom's

channel of trade." Petition, p. 9. The opinion does not set forth any such rule of law. Instead, the First Circuit engaged in a detailed and thorough analysis of the specific claims of changed circumstances -- both factual and legal -- raised by petitioner in this case. *DeCosta III*, A5-23. Based on its analysis of the particular facts of this case, the Court correctly found that no significant change had occurred. *DeCosta III*, A3, A5, A10, A12, A23.

STATEMENT OF THE CASE

This action arises out of the licensing for syndication of a television western, "Have Gun -- Will Travel" (the "Series"), which has aired continuously since 1957. The Series was created, produced, and first broadcast by CBS. CBS premiered the Series on prime-time network

television in September 1957, continued to broadcast it as a first-run program until 1964, and licensed the show for syndication until 1970. In 1970, when the Federal Communications Commission ruled that networks could no longer syndicate programs they had created, CBS spun off Viacom as a separate entity, assigning to it its syndication rights. Since that time, Viacom has continuously offered the Series for syndication. Record on Appeal (hereinafter "Record"), at 860-61, 865, 873. There is no evidence in the record of any other activity on the part of Viacom with respect to the Series.

Petitioner's Prior Litigation

In 1963, petitioner Victor DeCosta sued CBS and its affiliates, alleging trademark infringement, unfair competition, and misappropriation.

Petitioner claimed then, as he does now, that he originated the phrase "Have Gun Will Travel" and a character called "Paladin," which is also the name of a character featured in the Series. Record at 26. The central issue in the prior litigation was whether the broadcast (including syndicated broadcasts) of the Series violated any of petitioner's rights, including common law service mark rights.

Petitioner's case first reached this Court in 1967. At that time, the First Circuit had reversed a jury verdict in petitioner's favor on his claim of misappropriation, and remanded for a trial on the remaining claims of trademark infringement and unfair competition. This Court denied the petition for certiorari.

DeCosta I, *supra*, 377 F.2d 315, *cert. denied*, 389 U.S. 1007 (1967).

The First Circuit addressed petitioner's claims a second time in 1975, reversing again the lower court's finding of liability on the trademark and unfair competition claims.[2] The First Circuit held that petitioner was not entitled to any relief because there was no likelihood of confusion between petitioner's activities -- making personal appearances as "Paladin" -- and CBS' broadcast of the Series. Once more, this Court refused to grant certiorari. *DeCosta II*, *supra*, 520 F.2d 499 (1st Cir. 1975), *cert. denied*, 423 U.S. 1073 (1976) (A86).

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[2] By this time, Viacom had been syndicating the Series for five years.

Petitioner's Use of His Service Mark

In 1977, subsequent to the CBS litigation, petitioner obtained registration of a service mark. The registration is for the slogan "Have Gun Will Travel -- Wire Paladin," together with the image of a chess-set knight, for use in connection with

> SERVICES -- NAMELY, PROVIDING ENTERTAINMENT BY MAKING APPEARANCES AS A WESTERN CHARACTER AT RODEOS, PARADES, HOSPITAL FUNCTIONS, AND OTHER CIVIC, RELIGIOUS AND PRIVATE FUNCTIONS.

Opp. App., 3. Thus, petitioner was granted registration for the precise use -- and *only* for that use -- that was the subject of the prior litigation. Since obtaining registration, petitioner has continued to use his mark in the same manner that he had been using it during his prior litigation. A20.

The "New" Action

Petitioner brought this "new" action on October 31, 1989, alleging trademark infringement in violation of the Lanham Act (15 U.S.C. § 1114) (Opp. App., 4), common law trademark infringement, unfair competition in violation of the Lanham Act (15 U.S.C. § 1125(a)) (Opp. App., 5), common law unfair competition, and infliction of emotional distress.[3] A65. A side-by-side comparison of petitioner's

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[3] Count II of the complaint, alleging common law trademark infringement, also referred to "misappropriation." However, at the close of the evidence, the district court refused to charge the jury on misappropriation. The district court dismissed petitioner's claim for emotional distress at the close of petitioner's case.

1966 complaint with the "new" complaint reveals that petitioner simply rehashed his earlier complaint, with minor editing:

1966 COMPLAINT	1989 COMPLAINT
6. In or about the year 1947, the Plaintiff, Victor DeCosta, conceived the idea of a legendary western hero named Paladin, who, wearing a moustache, would dress in a black outfit and white tie, wear a black hat with a medallion in the center, and use as his card the legend, "Have Gun Will Travel, Wire Paladin." His symbol, engraved on said card, was a chess knight piece.... Such idea had never been so presented in the United States and was conceived as an original idea to be utilized by the Plaintiff	3. In or about the year 1947, the Plaintiff, then a rodeo rider, conceived the idea of a legendary western hero named "Paladin", who, wearing a moustache, would dress in a black outfit and white tie, wear a black hat with a medallion in the center, and use as his calling card the legend, "Have Gun Will Travel, Wire Paladin." The "Paladin" character and its accouterments, symbol and slogan had never been so presented in the United States and was conceived as an original idea to be utilized by the Plaintiff

himself in furnishing public entertainment on a large scale in the United States and foreign countries.

7. The Plaintiff, at various times from 1947 through and including 1957 and to date, has appeared at numerous rodeos and public and private shows

throughout the eastern part of America, dressed as Paladin and using as his symbol the business card as aforestated.

himself in furnishing public entertainment throughout the United States.

4. From 1947 to date, Plaintiff has continuously appeared at numerous rodeos, public and private horseshows, parades and charitable functions throughtout [sic] the eastern United States, dressed as the character "Paladin" and using as his symbol the aforementioned business card.

A65-66; Record at 26 (emphasis added). The complaints continue in tandem, recounting CBS's broadcast and syndication of the television series, with the only salient distinction being the substitution in the "new" complaint of the name Viacom for CBS.

In lieu of answer, Viacom moved to dismiss the complaint as barred by the doctrines of res judicata, collateral estoppel, and laches. Record at 22. The district court denied the motion, refusing to give preclusive effect to the prior judicial determination against petitioner. *DeCosta v. Viacom International Inc.*, 758 F. Supp. 807 (D.R.I. 1991) (A24). The case was tried to a jury from September 10 to September 19, 1991. On September 23, the jury returned its verdict, finding for petitioner.

The First Circuit's Opinion

By Opinion dated December 17, 1992, the First Circuit unanimously reversed the judgment of the district court and directed entry of judgment for Viacom, on the ground that petitioner's claims are barred by the doctrine of collateral

estoppel. In doing so, the First Circuit squarely addressed each claim of changed circumstances -- both legal and factual -- raised by petitioner.

First, the Court rejected petitioner's argument that registration of his mark changed the burden of proof, making it easier for petitioner to prove likelihood of confusion. While the First Circuit acknowledged that registration does affect the burden of proof on the questions of ownership and validity, neither of those was at issue in *DeCosta II* or in this action. The Court then correctly held that registration did not change the burden of proof on likelihood of confusion -- the dispositive issue that was decided against petitioner in *DeCosta II*:

> DeCosta is right that a change in relevant "burden of proof" rules

> can transform a legal issue, permitting relitigation of an issue that "collateral estoppel" otherwise would bar. But, we can find no such relevant transformation here. Registration consists of persuading the Trademark Board to issue an appropriate "certificate." The relevant statute says that the certificate becomes "prima facie evidence" of the marks' "registration," of its "validity," of "the registrant's ownership," and of the registrant's exclusive right to use the mark in connection with the goods or services specified in the certificate." . . . But, the statute nowhere says that registration makes it easier for a registrant (with a conceded right to use a concededly valid mark that he concededly owns) to prove that a relevant buying public may confuse some other person's mark with his own.

DeCosta III, A7 (citations omitted).

Second, the First Circuit was unpersuaded by petitioner's argument that the law has significantly changed since his prior litigation. *DeCosta III*, A10-18.

Finally, the First Circuit addressed petitioner's claim of changed factual

circumstances -- *i.e.*, alleged expanded use -- and found that there was no evidence that petitioner had significantly changed the use of his mark since his prior lawsuit:

> After reviewing the record, we conclude that DeCosta has not presented evidence of significantly different circumstances for two reasons. First, much of his evidence amounts to no more than added efforts to prove the same "ultimate facts" he failed to prove the first time. . . . We simply do not see why this kind of evidence could not have been provided the first time. Nothing in the record convincingly explains why those who saw DeCosta when the Paladin television program was current would have been any less "confused" than those who now see him when "Paladin" is the subject of old television reruns.
>
> Second, DeCosta provided evidence of his having expanded his own activities since 1977. . . .
>
> This evidence basically shows no more than the same kind of activity in which DeCosta previously engaged. And, we do not see how it can bring him outside the "collateral estoppel" bar.
>
> * * *

> The problem for DeCosta is that his evidence does not show a significant change.

DeCosta III, A19-20, A23 (citation omitted).

By Order entered February 3, 1993, the First Circuit denied petitioner's petition for rehearing. Opp. App., 1-2.

SUMMARY OF ARGUMENT

Petitioner's previous litigation resulted in a final adjudication of no "likelihood of confusion" between petitioner's use of his service mark for appearances as a western character, and the broadcast (including syndicated broadcast) of the Series. The First Circuit expressly found that neither the facts nor the law have changed since the prior litigation. Accordingly, the First Circuit was correct in holding that, under the doctrine of collateral estoppel, the

prior finding of no "likelihood of confusion" bars petitioner's "new" complaint. *DeCosta III*, A3, A5, A10, A12, A23.

ARGUMENT

THE FIRST CIRCUIT CORRECTLY HELD THAT COLLATERAL ESTOPPEL BARS PETITIONER'S SECOND ACTION FOR SERVICE MARK INFRINGEMENT AND UNFAIR COMPETITION, BECAUSE (1) PETITIONER'S PRIOR ACTION WAS BASED UPON THE SAME CONDUCT BY PETITIONER AND BY RESPONDENT'S PREDECESSOR-IN-INTEREST, (2) THE PRIOR ACTION RESULTED IN A FINAL JUDGMENT AGAINST PETITIONER ON THE GROUND THAT CONCURRENT USE OF THE MARK WAS NOT LIKELY TO CAUSE CONFUSION, AND (3) NEITHER THE FACTS NOR THE LAW HAVE CHANGED SINCE THE PRIOR JUDGMENT

POINT I

THE FIRST CIRCUIT CORRECTLY HELD THAT PETITIONER'S CLAIMS ARE BARRED BY COLLATERAL ESTOPPEL BECAUSE NEITHER PARTY'S USE OF THE MARKS HAS CHANGED

A. THE FIRST CIRCUIT EXPRESSLY AND CORRECTLY HELD THAT THERE ARE NO CHANGED CIRCUMSTANCES IN THIS CASE

Petitioner's entire petition rests on a misrepresentation of the First Circuit's opinion in this case. Petitioner would

have this Court believe that the First Circuit did not follow the precedent it set in *Sarah Coventry, Inc. v. T. Sardelli & Sons, Inc.*, 526 F.2d 20, 23 (1st Cir. 1975), *cert. denied*, 426 U.S. 920 (1976). In that case, the First Circuit held that a prior finding of no likelihood of confusion will not bar a subsequent action if circumstances of the party's use have changed. Petition, p. 8. In fact, the First Circuit acknowledged this precedent, specifically and clearly holding that, in this case, the parties' circumstances have not changed:

> DeCosta reminds us that, since findings of likelihood of confusion can turn on the relation of the parties' uses, a prior finding of no likelihood of confusion will not always bar a subsequent action if circumstances of the parties' uses change. *Sarah Coventry, Inc. v. T. Sardelli & Sons, Inc.*, 526 F.2d 20, 23 (1st Cir. 1975), *cert. denied*, 426 U.S. 920 (1976). **The problem for**

> **DeCosta is that his evidence does not show a significant change.**

DeCosta III, A23 (emphasis added).

This holding is completely consistent with the jurisprudence of this Court and each of the Circuit Courts that have addressed the issue. *See EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 746 F.2d 375, 377-78 (7th Cir. 1984) (plaintiff collaterally estopped by finding of no likelihood of confusion, despite plaintiff's subsequent registration of mark); *Berlitz Schools of Languages, Etc. v. Everest House*, 619 F.2d 211, 215 (2d Cir. 1980) (affirming application of collateral estoppel where the defendant's use of the mark in the second action was not "substantially different" from its use of the mark in the first action); *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 9 (1st

Cir. 1981) (prior finding that term "LITE" is generic collaterally estops plaintiff in subsequent infringement action where there was no evidence that the term had lost its generic meaning); *Flavor Corporation of America v. Kemin Industries, Inc.*, 493 F.2d 275, 281 (8th Cir. 1974) (prior finding of likelihood of confusion in cancellation proceeding precludes relitigation of issue in subsequent infringement action under doctrine of collateral estoppel); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 3d Edition, § 32:28[1], at 32-109 to 32-110 ("[i]t seems clear that a party in the second suit is collaterally estopped from relitigating such issues as . . . the presence or

absence of a likelihood of confusion between two trademark usages").[4]

In contrast, petitioner has not cited a single case that conflicts with the actual holding below.

Petitioner also argues that the First Circuit overlooked evidence of alleged expanded use. Not only do issues of sufficiency of the evidence not warrant certiorari by this Court, but petitioner's statements are contradicted by the record.

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[4] *See also Valcom Corp. v. Valmont Industries, Inc.*, 820 F.2d 1220 (4th Cir. 1987), *recons. denied*, 864 F.2d 150 (Fed. Cir. 1988) (plaintiff precluded by collateral estoppel from relitigating issue of likelihood of confusion); *Love v. The Family Circle, Inc.*, 793 F.2d 1292 (6th Cir. 1986) (prior finding of no likelihood of confusion in an action by plaintiff against defendant's parent company precluded plaintiff from showing likelihood of confusion in action against subsidiary). Both of these opinions are unpublished.

The First Circuit meticulously detailed the evidence of expanded use as follows:

> DeCosta provided evidence of his having expanded his own activities since 1977. He says, for example, that since that time, he has distributed 60,000 more calling cards (having distributed about 300,000 before 1977); 15,000 more photographs (having distributed about 20,000 before 1977); 15,000 bumper stickers, and 2800 pens bearing the Paladin legend. He has made more appearances at rodeos and ice cream stores, and he appeared on two television talk shows and in one television commercial. A picture of him in costume appeared once in a horsebreeder's magazine. And, he has objected several times to others using slogans such as "Have Cup, Will Travel" (by Dunkin Donuts) and "Have Guns, Will Travel" (by the U.S. Air Force).
>
> This evidence basically shows no more than the same kind of activity in which DeCosta previously engaged. And, we do not see how it can bring him outside the "collateral estoppel" bar.

DeCosta III, A20.[5] In the face of this

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[5] Petitioner's assertion that he has now made appearances as Paladin in "three-quarters of the United States" (Petition, (continued...)

particularized recitation, plaintiff's contention rings hollow.

B. AS AN INDEPENDENT ALTERNATIVE GROUND, THE FIRST CIRCUIT CORRECTLY HELD THAT, EVEN IF PETITIONER HAD EXPANDED INTO TELEVISION, WHICH HE HAS NOT, HIS CLAIMS WOULD STILL BE BARRED BY THE PRIOR FINDING OF NO LIKELIHOOD OF CONFUSION

Having determined that collateral estoppel bars petitioner's claims because there is no evidence that petitioner has expanded the use of his mark, the First Circuit also articulated an alternative,

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[5](...continued)
p. 9) is not only unsupported by concrete evidence, but irrelevant. As the First Circuit noted, these appearances are the same kind of activity in which petitioner previously engaged, and therefore do not constitute an expanded use. Moreover, contrary to petitioner's claims, the First Circuit's decision in *DeCosta II* did not hinge on its finding that petitioner's use of his mark was localized, and CBS's was nationwide. *See* Petition, p. 4. While the Circuit Court did take that fact into account, the Court weighed all the factors relevant to the likelihood of confusion analysis and found that no confusion was likely. *Decosta II*, A99-103.

independent ground for directing judgment for Viacom. The Court held that even if petitioner had produced evidence of expansion into television -- which he had not -- Viacom would still prevail:

> [The] evidence basically shows no more than the same kind of activity in which DeCosta previously engaged. And, we do not see how it can bring him outside the "collateral estoppel" bar. Even were he to have provided evidence of his own, far greater, expansion into, say, the television business, that evidence would do him no good.

DeCosta III, A20.[6]

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[6] The First Circuit did *not* hold that "DeCosta has made commercial use of his mark in the television medium." Petition, p. 9. The evidence revealed that the sum total of petitioner's limited activities in television are as follows: petitioner appeared in one commercial for a local Nissan dealership for which he was paid $200 (Record at 321, 454), and he was interviewed on two *local* talk shows, "Russ Gorman on Astrology," and "The Jerry Rivet Show," broadcast on local television stations in Attleboro and New Bedford, Massachusetts, respectively. Record at 244-46, 455-57. Petitioner did not

(continued...)

The Court reasoned that because CBS, and its successor in interest, Viacom, had priority in the field of television, and because there has already been a finding that there is no likelihood of confusion between petitioner's use and CBS/Viacom's use, petitioner's rights do not permit him to exclude CBS/Viacom from television:

> The litigated holding of "no confusion" in the initial DeCosta cases amounts to a holding that DeCosta had no legal right to exclude

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[6](...continued)
provide entertainment services as a western character on these talk shows, but appeared only as Victor DeCosta to discuss his life experiences, and particularly his litigation with CBS. Record at 455-56. Essentially, petitioner brought a lawsuit for service mark infringement, lost the lawsuit, went on two television talk shows to talk about his case, and then sued again claiming expanded use based on those television "appearances." Thus, the First Circuit noted that petitioner "appeared on two television talk shows and in one television commercial," but did not find that petitioner had expanded the use of his mark into television. *DeCosta III*, A20.

> others from using his mark in the field of television. Moreover, DeCosta has conceded that CBS/Viacom has used the "Paladin" mark in that field before, and after, he brought his initial cases.

DeCosta III, A20.

This independent ground -- while not necessary to the Court's holding directing judgment for Viacom -- is fully in accord with existing law.

As petitioner acknowledges, where a senior user and a junior user deal in non-competing goods and services, the senior user *may* have priority over the junior user in the junior user's field *if* the senior user's expansion is "natural," i.e., the goods or services are "related." Petition, p. 15. Petitioner also acknowledges that this test for determining priority in the junior user's field (in this case, television), focusses on whether the uses are likely to cause

confusion; in other words, if the use in the junior user's field is likely to cause confusion with the senior user's use, the junior user's field is "related" to, or is a "natural expansion" of, the senior user's field. Petition, pp. 15-16. *See* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24:06[2][A] at 24-43 (test for determining priority is the same as the ultimate "likelihood of confusion" test). Petitioner then argues that because each Circuit has a slightly different "likelihood of confusion" test, the issue of whether petitioner has priority in television merits review by this Court. Petition, pp. 15-17.

This argument misses the point. Petitioner fails to advise the Court that priority is determined by evaluating whether there was a likelihood of

confusion *at the time of the junior user's entrance*:

> When a senior user of a mark on product line A expands later into product line B and finds an intervening user, priority in product line B is determined by whether the expansion is "natural" in that customers would have been confused as to source or affiliation *at the time of the intervening user's appearance*.

1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 16.02[1][b] at 16-7 (emphasis added). *See also Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 U.S.P.Q. 956, 962 (TTAB 1985) ("the determination of whether an expansion is or would be natural must be made on the basis of the circumstances prevailing at the time when the subsequent user first began to do business under its mark, i.e. what was "natural" in the relevant trade at that time"); *Viking Boat Co. Inc. v. Viking*

Camper Supply, Inc., 191 U.S.P.Q. 297, 303 (TTAB 1976) (the question of natural expansion must be viewed not in the light of present trade practices but in the light of trade practices at the time when the junior user began doing business under mark).

In this case, *DeCosta II* is a prior adjudication that at the time of the "intervening user's" appearance (and, indeed, throughout the twenty years that followed), there was no likelihood of confusion. Thus, for the particular uses challenged here, the issue of priority was determined by the prior infringement action.

Indeed, Professor McCarthy explains that the "natural expansion" test for priority is identical to the test for

infringement at the time the junior user (here, CBS/Viacom) began using the mark:

> The "natural expansion" thesis seems to be nothing more than an unnecessarily complicated application of the likelihood of confusion of source or sponsorship test to a particular factual situation. If the "intervening" use was likely to cause confusion, it was an infringement, and the senior user has the right to enjoin such use, whether it had in fact already expanded itself or not.

2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24.05[4] at 24-37 (footnotes omitted). Here, where it was adjudicated that the "intervening" use was *not* likely to cause confusion, that the use was *not* an infringement, and that the "senior user" did *not* have the right to enjoin such use,

the "expansion" was not "natural" and the "junior user" (CBS/Viacom) has priority.[7]

Accordingly, the First Circuit correctly concluded that its decision in *DeCosta II* was tantamount to a determination that CBS/Viacom's services are not related to petitioner's (put another way, that television is not a "natural expansion" of plaintiff's mark), and that therefore CBS/Viacom, not petitioner, has priority in the field of television. *DeCosta III*, A 20-22.[8]

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[7] Moreover,

> [A] senior user cannot by expansion prevail where the result would be a likelihood of confusion in derogation of established rights of the intervening user.

2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24.05[4] at 24-37 (footnotes omitted).

[8] Thus, even assuming that the particular "likelihood of confusion" factors that each Circuit considers may vary slightly, that issue could not

(continued...)

Petitioner's discussion of the "TEA ROSE-Rectanus" defense is irrelevant. Petition, pp. 11-13. Viacom has never argued that it was unaware of petitioner's mark, and the First Circuit did not base its holding upon any such defense. Indeed, the "TEA ROSE-Rectanus" rule has nothing whatsover to do with this case.[9]

Similarly, as petitioner himself admits, petitioner's discussion of *Raxton Corp. v. Anania Associates, Inc.*, 635 F.2d 924 (1st Cir. 1980), is irrelevant. That case dealt with territorial expansion, and

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[8](...continued)
properly be before the Court on this Petition. The sole issue in this case is the preclusive effect of the prior adjudication.

[9] The First Circuit did cite *United Drug Co. v. Rectanus Co.*, 248 U.S. 90 (1918), as part of a string of citations relating to priority. *DeCosta III*, A22. However, the Court did not discuss the case, and did not depend on it in its reasoning or holding.

as petitioner admits, this is not a case about geographical boundaries. Petition, p. 15.

C. THE FIRST CIRCUIT DID NOT NEED TO REACH AND DID NOT REACH THE ISSUE OF WHETHER PETITIONER ESTABLISHED "LIKELIHOOD OF CONFUSION"; ACCORDINGLY, THAT ISSUE IS NOT REVIEWABLE BY THIS COURT

It is Viacom's position that as a matter of law, petitioner submitted insufficient evidence to establish likelihood of confusion in this action. The issue was discussed at length by both parties in their briefs to the First Circuit. However, because the First Circuit held that petitioner's action was precluded by collateral estoppel, it did not have to reach, and did not reach, the issue of whether the evidence submitted could support a finding of likelihood of confusion. Accordingly, that issue is not reviewable by this Court.

POINT II

THE FIRST CIRCUIT CORRECTLY HELD THAT THE MERE FACT OF TRADEMARK REGISTRATION, STANDING ALONE, DOES NOT VITIATE THE PRECLUSIVE EFFECT OF THE FIRST CIRCUIT'S PRIOR FINDING OF NO LIKELIHOOD OF CONFUSION

The First Circuit properly held that the mere fact that petitioner has registered his trademark since *DeCosta I* and *DeCosta II* does not permit relitigation of the "likelihood of confusion" issue, because registration relates to ownership and validity, not to likelihood of confusion:

> DeCosta is right that a change in relevant "burden of proof" rules can transform a legal issue, permitting relitigation of an issue that "collateral estoppel" otherwise would bar. But, we can find no such relevant transformation here. . . . The relevant statute says that the certificate [of registration] becomes "prima facie evidence" of the marks' "registration," of its "validity," of "the registrant's ownership," and of the registrant's exclusive right to use the mark in connection with the goods or services specified in the

> certificate." . . . But, the statute nowhere says that registration makes it easier for a registrant (with a conceded right to use a concededly valid mark that he concededly owns) to prove that a relevant buying public may confuse some other person's mark with his own.

DeCosta III, A7 (citations omitted).

This holding is consistent with both the Lanham Act and the decisions of other courts. *See* 15 U.S.C. §§ 1057(b), 1065, 1115; *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, *supra*, 746 F.2d at 377-79 ("[w]e do not find that the procedural advantages conferred by registration are substantial, at least in the context of determining the issue of likelihood of confusion. Therefore, we see no inequity in applying collateral effect to the decision of the Court of Appeals for the Federal Circuit"); *PPG Industries, Inc. v. Clinical Data, Inc.*, 620 F. Supp. 604, 607 (D. Mass. 1985) (giving collateral

estoppel effect to holding of no likelihood of confusion despite intervening registration).[10]

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[10] Moreover, the Lanham Act specifically provides that the procedural and evidentiary benefits of registration and incontestability relate to the use of the mark "on or in connection with the goods or services specified in the registration." 15 U.S.C. § 1115(a) (A110); 15 U.S.C. § 1115(b) (emphasis added) (A110). *See, e.g.*, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24.12[2][a] at 24-104 ("the prima facie and incontestable provisions of the Lanham Act apply only to the goods or services specified in the registration"), and cases cited therein.

The benefits of registration and incontestability do *not* apply where, as here, the infringement claim is based on a theory of allegedly "related" services, and services identical to or competing with the services listed in the certificate. *See Natural Footwear Ltd. v. Hart, Shaffner & Marx*, 760 F.2d 1383 (3d Cir.), *cert. denied*, 474 U.S. 920 (1985); *Avon Shoe Co. v. David Crystal, Inc.*, 279 F.2d 607 (2d Cir.), *cert. denied*, 364 U.S. 909 (1960); *Westwood One, Inc. v. National Broadcasting Co.*, 215 U.S.P.Q. 380 (C.D. Cal. 1982); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §32.43[3][b] at 32-165; 3 J. Thomas McCarthy, *McCarthy on Trademarks and*

(continued...)

There are no cases that conflict with this holding. The two cases relied upon by petitioner, *American Heritage Life Insurance Co. v. Heritage Life Insurance Co.*, 494 F.2d 3 (5th Cir. 1974) and *Dieter v. B & H Ind.*, 880 F.2d 322 (11th Cir. 1989), *cert. denied*, 498 U.S. 950 (1990), were specifically explained and distinguished by the First Circuit.

The *Dieter* court held that incontestability is relevant to likelihood of confusion because incontestability establishes that a mark is strong enough to be protectable, and strength is a factor to be taken into account in the likelihood of confusion analysis. Acknowledging without approving this

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[10](...continued)
Unfair Competition, § 32.44[5][e] at 32-183.

analysis,[11] the First Circuit held that in this case a presumption of strength did not affect the prior decision because petitioner's mark was already assumed to be strong in *DeCosta II*:

> That "strength" relates to confusion and registration "relates" (in this way) to strength, however, does not help DeCosta. The "strength" of DeCosta's mark was not an issue before us in the earlier cases. This court assumed in its opinions that DeCosta's mark had a secondary meaning. It specifically said that his mark is "distinctive enough so that proof of secondary meaning is not essential," . . . *DeCosta II*, 520 F.2d at 513. It went on to find no relevant "confusion," even assuming a mark as strong as registration might have forced it to

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[11] *Dieter* has been criticized by Professor McCarthy as contrary to the holdings of virtually all other authorities on the issue. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 32.44[7][b] at 32-189. *See also Lindy Pen Co. v. Bic Pen Corp.*, 725 F.2d 1240, 1247 (9th Cir. 1984) ("incontestability of a mark may protect the registrant's mark from cancellation, but is of no offensive use"), *cert. denied*, 469 U.S. 1188 (1985).

> assume. Thus, the fact of later registration, insofar as it helps establish that the mark has a "secondary meaning," adds nothing significantly new.

DeCosta III, A9.

With respect to *American Heritage*, the First Circuit held:

> We concede that, in one of the cases that DeCosta cites, the court said that "registration is sufficient to establish prima facie (1) the required prior use (2) of a registrable mark (3) which is *likely to be confused* with another's use of the same or a similar mark." *American Heritage*, 494 F.2d at 10 (emphasis added). The underlined phrase, however, likely refers simply to the mark's "strength," in which case the phrase is consistent with holdings in other courts.

DeCosta III, A9-10.[12]

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[12] Indeed, the reach and impact of petitioner's argument (which essentially creates a presumption of liability) is staggering. Under petitioner's interpretation of *American Heritage*, whenever an owner of a registered mark brings an action for infringement or unfair competition, the burden is on the defendant to establish that his use is not

(continued...)

Finally, while the Petition contains a list of the benefits of registration (Petition, pp. 28-29), the one benefit that petitioner seeks to create is conspicuously absent: a presumption of likelihood of confusion. Although the "presumptions" listed by petitioner do affect the burden of proof in an infringement action (Petition, p. 29), as the First Circuit properly held, these "presumptions" have no impact on the issue that was decided against petitioner in *DeCosta II*: likelihood of confusion.

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[12](...continued)
likely to cause confusion, no matter how disparate the uses and contexts. If Congress had intended to shift the burden of persuasion in such a dramatic manner, Congress would have said so in the Lanham Act. Moreover, in light of the fact that the Patent and Trademark Office ("PTO") has registered thousands of marks, it is rather extraordinary that no court (nor the PTO itself) has ever applied such a presumption, and only one court has ever even arguably referred to it.

POINT III

MISSTATEMENTS IN THE PETITION

Pursuant to Supreme Court Rule 15.1, it is respondent's obligation to point out any misstatements of law or fact set forth in the petition. In addition to those misstatements set forth above, the Petition contains the following errors:

* Petitioner's use of the present tense in describing "DeCosta's Paladin" (Petition, p. 2), and the photographs annexed to the Petition as A106, are misleading. Petitioner's service mark registration specifies that the mark is for services

> NAMELY, PROVIDING ENTERTAINMENT BY MAKING APPEARANCES AS A WESTERN CHARACTER AT RODEOS, PARADES, HOSPITAL FUNCTIONS, AND OTHER CIVIC, RELIGIOUS AND PRIVATE FUNCTIONS.

Opp. App., 3. Both petitioner's registration -- and his actual use of the

mark -- have been limited to appearances that he has personally made. However, the photograph submitted by petitioner was taken in 1947, twenty-three years before Viacom came into existence. Record at 260, 1059. It has been decades since petitioner's appearance mirrored that in the photograph, and at least sixteen years since he performed on horseback. Record at 408, 416. Accordingly, the photograph submitted by petitioner is not an accurate portrayal of the use of the mark and is irrelevant.

* While the First Circuit's decision in *DeCosta I* was initially criticized as misinterpreting this Court's decisions in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Daybright Lighting, Inc.*, 376 U.S. 234 (1964), this Court's subsequent decision

in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), establishes that *DeCosta I* was correctly decided. *See* Petition, p. 3.

* Petitioner's characterization of the evidence of alleged expanded use is not only misleading, it is directly contradicted by the findings of the First Circuit, which described the evidence of expanded use in detail. *Compare* Petition, p. 6, with *DeCosta III*, A20.

* Petitioner's claim that he "received offers for motion picture use of his mark and character" (Petition, p. 6) is utterly without support in the trial record, and is a misrepresentation of the information obtained by petitioner during discovery. The only reference in the record to film is counsel's attempt to elicit hearsay testimony from petitioner

regarding conversations with a producer named Thom Mount. Counsel for Viacom objected on hearsay grounds to each question relating to the substance of the conversations; each objection was sustained.

In fact, petitioner was constrained to attempt to make his point through inadmissible hearsay evidence because had Mr. Mount testified, he would have testified to a different story. When petitioner's counsel deposed Mr. Mount prior to trial, Mr. Mount testified:

> [I was] *looking around for a television show* that had a pre-sold name value that can be turned into an interesting feature, and I remember this old show Have Gun Will Travel.

* Petitioner's reference to "Viacom's active efforts to prevent the unrestricted registration of DeCosta's mark" is misleading. Petition, pp. 6, 12.

CBS, not Viacom, opposed petitioner's registration. The sole evidence in the record of Viacom's participation is a single, two-page affidavit submitted by a Viacom representative setting forth Viacom's syndication activities. Record at 1067-68.

* Petitioner states that the District Court and jury specifically found bad faith use by Viacom. Petition, p. 12. However, petitioner fails to advise the Court that this finding was explicitly rejected by the First Circuit:

> the record provides no evidence at all that, since 1977, CBS or Viacom has used the mark in "bad faith" . . . Indeed, CBS/Viacom might reasonably have relied upon our prior final judgment . . . .

DeCosta III, A20-21. As he did at trial, petitioner continues erroneously to equate Viacom's knowledge of petitioner's mark with bad faith. However, as the First

Circuit recognized, "bad faith" refers to the intent to cause confusion or trade on another's reputation or good will. A21.

* The First Circuit did not "acknowledge . . . overwhelming proof of likelihood of confusion in the record." Petition, p. 6. No such statement appears anywhere in the opinion. Indeed, as set forth extensively in Viacom's appellate briefs, in 1975 the First Circuit reviewed the lower court's finding of likelihood of confusion, and held that, after eleven years of concurrent use by the parties, the evidence could not support a finding of likelihood of confusion. *DeCosta II*, A102-103. Now, after thirty-four years, petitioner has produced even less evidence of confusion and no evidence of confusion caused by Viacom.

CONCLUSION

Petitioner had a full and fair opportunity to litigate the issue of whether the broadcast of the television series, "Have Gun Will Travel," was likely to cause confusion with petitioner's use of his mark in connection with his appearances as a western character. That thirteen-year litigation against CBS resulted in a final judgment against petitioner on the ground that concurrent use of the mark was not likely to cause confusion. Now, seventeen years after this Court refused to grant certiorari, and thirty-six years after the Series was first broadcast, petitioner brings the same claims against CBS' successor in interest, Viacom, despite the fact that neither party's use of the mark has expanded. As the First Circuit properly

held, petitioner's claims have already been adjudicated, and are therefore barred by collateral estoppel.

Dated: New York, New York
May 26, 1993

Respectfully submitted,

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New York, New York 10169
(212) 818-9200

APPENDIX

APPENDIX

Viacom International Inc.'s Statement Pursuant to Supreme Court Rule 29.1 1

DeCosta v. Viacom International Inc., No. 91-2211, 1st Circuit (February 3, 1993) 4

Plaintiff's Trademark Registration . 6

15 U.S.C. § 1114(1)(a) 7

15 U.S.C. § 1125(a)(1)(A) 8

APPENDIX
PAGE 1

STATEMENT PURSUANT TO
SUPREME COURT RULE 29.1

Film Intex Corporation
Tele-Vu Ltee.
VE Productions Inc.
Viacom Canada Limited
Viacom Enterprises Canada Limited
Viacom First Run Limited
Viacom First Run Development Company Inc.
VJK Inc.
Viacom International Limited
Viacom International Pty. Limited
Viacom Japan Inc.
Viacom Pacific Limited
Viacom Productions Inc.
Jake and the Fatman Productions Inc.
Low Key Productions Inc.
The Matlock Company
My Shadow Productions Inc.
PMV Productions Inc.
They Productions Inc.
VP Programs Inc.
Viacom S. A.
Viacom Video-Audio Comunicacoes Limitada
VSC Productions Inc.
Cable TV of Marin, Inc.
Clear View Cable Systems, Inc.
Com-Cable TV, Inc.
H-C-G Cablevision Inc.
Viacom Cablevision Inc.
Glendale Property Corp.
Marin Cable Television, Inc.
Television Signal Corporation
Tele-Vue Systems, Inc.
Broadview Television Company
Cable TV Puget Sound, Inc.
Channel 3 Everett, Inc.
Community Telecable of Bellevue, Inc.

Community Telecable of Seattle, Inc.
Contra Costa Cable Company
Crockett Cable Systems, Inc.
Everett Cablevision, Inc.
Far-West Communications, Inc.
United Community Antenna System, Inc.
Vista Television Cable, Inc.
Viacom Bay Area Sports Inc.
Viacom PNW Sports Inc.
Viacom Bay Interconnect Inc.
Viacom Cablevision of Dayton Inc.
Viacom Cablevision of No. California Inc.
Viacom DBS Inc.
Viacom K-Band Inc.
Viacom PCN Inc.
Viacom Shopping Inc.
VSC Cable Inc.
Glendale Property Corp.
Broadcast Leasing Inc.
KBSG Inc.
KHOW Inc.
KIKK Inc.
KIKK-FM Tower Corporation Inc.
KYSR Inc.
Riverside Broadcasting Co., Inc.
Viacom Broadcasting of Missouri Inc.
Viacom Broadcasting West Inc.
VSC Communications Inc.
WMZQ Inc.
WNYT Inc.
WVIT Inc.
Showtime Networks Inc.
All Media Inc.
Interstitial Programs Inc.
Part-Time Productions Inc.
Satellite Holdings Inc.
Showtime Networks Inc. (U.K.)
Showtime Networks Satellite Prog. Company
Showtime Satellite Networks Inc.

SNI Development Corp.
Toe-To-Toe Productions, Inc.
Viacom Pictures Inc.
Viacom Pictures Development Company
Viacom Pictures Movie Music Inc.
Viacom Pictures Overseas Inc.
Viacom Pictures Songs Inc.
Viacom Satellite News Inc.
Games Productions Inc.
Bardwire Inc.
Games Animations Inc.
QWERTY Inc.
Uptown Productions Inc.
MTV Australia Inc.
MTV Latin America Inc.
MTV Networks Company
MTV Networks Europe Inc.
MTV Songs Inc.
Music By Video Inc.
Nickelodeon Magazines Inc.
Remote Productions Inc.
Viacom Camden Lock Inc.
Viacom HA! Holding Company
Viacom Networks Europe Inc.
Nickelodeon Holdings U.K. Inc.
Nickelodeon Huggings U.K. Limited
Viacom VH-1 Holding Company
LT Holdings Inc.
ICOM Simulations, Inc.
Viacom International Inc. Political Action Committee Corp.
Viacom MGS Services Inc.
Viacom Networks Inc.
Viacom Telecommunications (D.C.) Inc.
Viacom World Wide Limited
VSC Compositions Inc.
VSC Music Inc.

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 91-2211

VICTOR DeCOSTA,
Plaintiff, Appellee,

v.

VIACOM INTERNATIONAL INC.,
Defendant, Appellant,

Before

BREYER, Chief Judge,
COFFIN, Senior Circuit Judge,
TORRUELLA, SELYA, CYR, BOUDIN and STAHL,
Circuit Judges.

ORDER OF COURT

Entered: February 3, 1993

The panel of judges that rendered the decision in this case having voted to deny the petition for rehearing and the suggestion for the holding of a rehearing en banc having been carefully considered by the judges of the court in regular

active service and a majority of said judges not having voted to order that the appeal be heard or reheard by the court en banc,

It is ordered that the petition for rehearing and the suggestion for rehearing en banc be denied.

By the Court:

Francis P. Scigliano

Clerk.

[cc: Messrs. Fowler, Karmen, Schreck, Callagy, Hagopian and Petrocelli]

Int. Cl.: 41
Prior U.S. Cl. 107 Reg. No. 1,059,696
United States Patent Office
Registered Feb. 15, 1977

SERVICE MARK
Principal Register

HAVE GUN WILL TRAVEL
[includes visual depiction of mark]
WIRE PALADIN

Victor DeCosta,
Rockland Road
Scituate, R.I. 02857

For: SERVICES -- NAMELY, PROVIDING ENTERTAINMENT BY MAKING APPEARANCES AS A WESTERN CHARACTER AT RODEOS, PARADES, HOSPITAL FUNCTIONS, AND OTHER CIVIC, RELIGIOUS AND PRIVATE FUNCTIONS -- in CLASS 107 (INT. CL. 41).

First use in or about July 1947; in commerce in or about July 1947.

Ser. No. 356,049, filed Apr. 6, 1970.

REGISTERED FOR A TERM OF 20 YEARS FROM Feb. 15, 1977

[certification and seal of United States Patent & Trademark Office]

15 U.S.C. § 1114

(1) Any person who shall, without the consent of the registrant --

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; . . .

* * *

shall be liable in a civil action by the registrant for the remedies hereinafter provided. . . .

15 U.S.C. § 1125

(a) (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact,

which --

(A) is likely to cuase confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, . . .

* * *

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act. . . .